

### **DETAILED ACTION**

1. This Office Action follows a response filed on January 7, 2008. No claims have been amended, cancelled or added.
2. Claims 1-19 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
4. Claim 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Sun et al. (U.S. Patent 6,124,391) in view of Le-Khac et al. (WO 96/30442), for rationale recited in paragraphs 7 and 8 of Office Action dated on September 13, 2006.
5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Sun et al. and Le-Khac as applied to claims 1-17 above, and further in view of Schulz et al. (U. S. Patent 5,869,033), for rationale recited in paragraph 7 of Office Action dated on September 25, 2007.

### ***Response to Arguments***

6. Applicants traverse the rejection of claims 1-17 under 35 U.S.C. 103(a) as being unpatentable as obvious over Sun et al. (U. S. Patent 6,124,391) and Le-Khac (WO 96/30442) and the rejection of claims 1-17 under 35 U.S.C. 103(a) as being unpatentable as obvious over Sun et al. and Le-Khac as applied to claims 1-17 above,

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and further in view of Schulz et al. (U. S. Patent 5,869,033). Applicant's arguments have been fully considered but they are not persuasive.

7. It appears that the focal Applicants argument resides in the contention that the *maximum* amount of inorganic powder added to the SAP particles, as disclosed in the '391 patent, is 10 wt%, in contrast the present claims specifically recite the *minimum* amount of about 15% (pages 7-8), and the presently claimed superabsorbent particles have a greater degree of crosslinking at the surfaces of the particles as a result of surface crosslinking (in addition to internal crosslinking) and, because the clay is applied with the surface crosslinker, the clay must be positioned at the vicinity of the surfaces of the particles, i.e., is not distributed throughout the volume of a particle (page 8, 3<sup>rd</sup> paragraph and pages 14-15, the bridging paragraph).

8. It is noted again (see the previous Office Action dated on September 25, 2007) that in view of substantially identical superabsorbent particles and the method of obtaining such particles between Sun and the Applicants, it is the examiner position that in both cases the clay partly present in the vicinity of surfaces of the superabsorbent particles. As it well known, an introducing of clay in the amounts about 10% as in prior art or about 15-35% as claimed by the Applicants, will cause not only *surface-crosslinked* superabsorbent particles containing the clay *in the vicinity of the surfaces* of the superabsorbent particles as per claim 1, but also homogeneously distributing of the clay throughout superabsorbent particles. It is well known that for achieving the effect of surface-crosslinking of superabsorbent particles it is enough the amount up to 10% of a surface-crosslinked compound, more preferably less than 5% (U. S. Patents 4,541,871,

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4,824,901, 4,789,861, 4,587,308, 4,734,478, 5,164,459, 4,020,780, 5,562,646, 5,599,335; WO-92/16565, WO-90/08789, WO-93/05080, EP-509708, etc.).

Therefore, it is clear, that if the composition contains up to 35% of the clay, this clay cannot be only in the vicinity of the surfaces of the superabsorbent particles, and the most part of it would be distributed throughout superabsorbent particles.

9. In response to applicant's argument that the reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the clay is not soluble in the surface crosslinking agent or any solvent used in the surface crosslinking step, and the clays are swelling or non-swelling, and accordingly are insoluble. The clay, as a solid, therefore, cannot penetrate deeply into the already formed superabsorbent particle to provide a particle having a clay homogeneously distributed throughout the particle (page 8, 1<sup>st</sup> paragraph), or that including a clay in the surface crosslinking step, in the claimed amount of about 15% to about 35%, by weight, provides the unexpected benefits of reducing the amount of fine-sized SAP particles and improving the fluid permeability of the clay-treated SAP particles (page 12, 3<sup>rd</sup> paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In response to Applicants objective evidence demonstrating the new and unexpected results (pages 9-10 and 12-13, the bridging paragraph), it is noted that the Applicants have to use the closest prior art (U. S. Patent 6,124,391) to run a consecutive "back-to-back" test to show unexpected results, if any. "Showing

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unexpected results over one of two equally close prior art references will not rebut prima facie obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other”. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984).

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.” “[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant’s heat shrinkable articles with those of the closest prior art, we conclude that appellant’s assertions of unexpected results constitute mere argument.”). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991). See MPEP 716.01(c).

It is worth to mention that these arguments were already made by Examiner in the previous Office Action dated on September 25, 2007.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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